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Date: September 25, 2006

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Andreas JUNGHANS, et al.
Serial No. : 10/737,211
Filed : December 16, 2003
For : PRESSURE SENSITIVE ADHESIVE FOR SINGLE- OR
DOUBLE-SIDED ADHESIVE SHEET STRIPS AND PROCESS
FOR THE PREPARATION HERETO
Art Unit : 1771
Examiner : Anish P. Desai

September 25, 2006

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' BRIEF ON APPEAL PURSUANT TO 37 CFR § 41.37

Sir:

This is an appeal from the final rejection of an Examiner of Art Unit 1771.

1. REAL PARTY IN INTEREST

The instant application is owned by tesa AG, record owner hereof.

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2. RELATED APPEALS AND INTERFERENCES

The undersigned is not aware of any appeals, interferences, reexaminations, infringement actions or the like in any related applications.

3. STATUS OF CLAIMS

The claims pending in this application are claims 1-7; all of said claims are finally rejected and all of said claims are on appeal.

4. STATUS OF AMENDMENTS

No amendments have been filed subsequent to final rejection.

5. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1 relates to a novel pressure-sensitive adhesive for adhesive sheet strips which are redetachable from a substrate without residue by stretching, and which have good bond strengths even on hydrophilic substrates, such as glass or ceramic, even at elevated atmospheric humidity (page 3, lines 6-10). The novel pressure-sensitive adhesive adhesives comprise at least one block copolymer and at least one tackifier, wherein at least one water-soluble polymer has been incorporated into the mixture (page 3, lines 13-15). Surprisingly, it has been found that as a result of the addition of water-soluble polymer it is possible to bring about a distinct increase in the holding power of the adhesive strips under moist conditions on hydrophilic substrates such as glass or ceramic (page 3, lines 4-10; page 4, lines 24-26).

6. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

The grounds for rejection to be reviewed on appeal are the rejection of claims 1-7 under 35 U.S.C. 103(a) as obvious over Lühmann et al. (US Patent 5,897,949) in

view of Horiki et al. (US Patent 4,868,045).

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7. ARGUMENTS

The Examiner views Lühmann as disclosing an adhesive tape which can be redetached by pulling, without residue and without damage, and views Horiki as disclosing a masking member that includes a water soluble polymer in its emulsion type adhesive to prevent the adhesive layer from transferring from the masking member to a surface which is being protected. The Examiner also reads Horiki as teaching that the water soluble polymer *may* increase the adhesive force of the adhesive and gives a releasing property to the adhesive. The Examiner also mentions (in the Advisory Action) that he sees Horiki's product as having excellent heat resistance.

From this, the Examiner concludes that it would have been obvious to those skilled in the art to add Horiki's water-soluble polymer to Lühmann's adhesive, motivated by the desire to improve the cohesive force and weatherability of the adhesive.

The Horiki reference is directed to providing an alternative to the known methods of preventing the adhesive from a masking tape from being left on a substrate when the masking tape is removed. Such masking tapes are typically removed from substrates by pulling them off, not by stretching. Nothing in Horiki teaches or suggests anything at all about an adhesive that is redetachable by stretching. The prior art methods

discussed by Horiki for preventing adhesive from a masking member from being transferred from the masking member to the substrate include the addition of a release agent in the adhesive composition (col. 1, line 31). However, the release agent brings about a deterioration of stickiness, weatherability, heat resistance and the like (col. 1, lines 39 – 42). Horiki solves this problem by eliminating the release agent and substituting a water-soluble polymer ("composition consisting essentially of ..."). As the Examiner notes, with reference to Col. 1, line 69, the weatherability of the resulting adhesive does not *deteriorate* (as it did when the release agent was used). This, obviously, is because the release agent, which is known to deteriorate weatherability (Col. 1, lines 39-42) is not present. Similarly, the addition of a release agent in the prior art brought about a deterioration of heat resistance (col. 1, lines 39-42), and Horiki also avoids this problem by avoiding the use of a release agent and substituting a water-soluble polymer. Horiki does not teach or suggest anything at all about *improving* weatherability or *improving* heat resistance; only about avoiding the deterioration of weatherability and heat resistance by avoiding the release agents which caused these problems. Nothing in Horiki would teach or suggest that water-soluble polymers improve weatherability or heat resistance. All Horiki teaches is that the removal of the release agent from the formulation eliminates the deteriorating effect that the release agent would have had on weatherability and heat resistance. This is very clear from the language beginning at Col 1, line 65 and continuing through Col 2, line 2. Horiki specifically teaches "...does not deteriorate...".

Therefore, contrary to the Examiner's assertions, Horiki clearly does not teach or

suggest that weatherability or heat resistance can be improved by the addition of water-soluble polymers, and there is no reason why any person skilled in the art would expect that a water-soluble polymer would bring about any improvement in weatherability or heat resistance. Accordingly, a desire for improved weatherability or heat resistance does not provide any motivation to add a water-soluble polymer...the reference teaches that water-soluble polymers have no effect on such properties.

The reason Horiki adds the water-soluble polymer to his adhesive is to impart a *releasing property* to the adhesive, while at the same time avoiding the traditional release agents which *do* affect weatherability and heat resistance, in a negative way (col. 1, line 63 - col. 2, line 2).

In concise terms, the Horiki reference adds a water-soluble polymer to an emulsion-type adhesive used on a masking tape. Horiki makes this addition because the water-soluble polymer may increase the cohesive force of the adhesive and at the same time give the adhesive a releasing property

In this regard, it should be noted that the Horiki reference is directed to a masking member which is used to "...protect a surface of an article from a surface treatment..." (Abstract). Thus, weatherability is a concern for Horiki. Lühmann, by contrast, does not concern a masking tape used to protect the surface of an article from a surface treatment, but rather is concerned with an adhesive for an entirely different use; to fix various articles to various substrates where they will remain until intentionally

removed. Weatherability is not a concern for Lühmann. Nothing in the exemplary applications indicated at Col 3, lines 45 - 58 of the Lühmann reference would raise any concerns about weatherability.

Furthermore, Lühmann's adhesive is, and is intended to be, removable *without residue*, by stretching (col. 2, lines 47-48). Horiki's adhesive tape, by contrast, is a masking tape, not a stretchable tape removable by stretching. Horiki's water soluble polymer is added to an adhesive which is not taught as being stretchable; and is not taught as being residueless. In fact, the addition of the water-soluble polymer is taught to "...prevent the adhesive layer ...from transferring to the surface of the article..." (Col. 1, lines 45-48).

Inasmuch as Lühmann's adhesive already is residueless, there is absolutely no reason why any person skilled in the art would be motivated to add anything to it to "...prevent the adhesive layer...from transferring to the surface of an article". This property is already present in Lühmann's adhesive. It is more likely that those skilled in the art would think a water-soluble polymer would be *detrimental* to Lühmann's adhesive, by making it more likely to absorb water and deteriorate.

Those skilled in the art, as well as those unskilled in the art, know that masking tapes are intended to have relatively low adhesive strength, so that they may be easily pulled off of a substrate; i.e., they are "temporary coverings".

Lühmann, on the other hand, teaches an adhesive tape which has a powerful bond to a substrate, but which bond can be broken by stretching the tape (col. 1, lines 6-12; col. 2, lines 28-29, lines 33-34). Clearly, the incorporation of "releasing property" to Lühmann's tape would be detrimental to the high bond strength that is intended for his tapes. Lühmann's tapes adhere strongly to substrates, and yet are removable without residue by stretching in the bond plane. There is therefore no reason to consider adding something that may increase the cohesive force (the cohesion is already so high that the tape can be removed without leaving any residue behind), and the addition of anything that would impart release properties would be avoided by those skilled in the art because they would not want to decrease the bond strength, which is intended to be high (until broken by stretching). Therefore, no person skilled in the art would ever consider adding Horiki's water soluble polymer to Lühmann's tape.

The Examiner contends that those skilled in the art would be motivated to add Horiki's water soluble polymer to Lühmann's tape "...to improve the weatherability of the adhesive and prevent the deterioration of the stickiness of the adhesive". There is, however, absolutely nothing in Horiki that would teach or suggest that a water soluble polymer would improve weatherability or prevent deterioration of stickiness. It is not seen where the Examiner finds any such representation by Horiki. All Horiki says about this is that his water soluble polymer does not cause the weatherability to deteriorate, and does not cause the stickiness to deteriorate (col. 1, lines 1-2). The absence of a negative does not mean the presence of a positive !

There is absolutely no support for the Examiner's reading of Horiki as teaching that a water soluble polymer can improve weatherability or prevent deterioration. All Horiki says is that his water soluble polymer is not itself harmful to such properties; in other words, that it has no effect on weatherability or stickiness.

There is absolutely no reason why any person would want to add Horiki's water soluble polymer to Lühmann's adhesive.

In the Advisory Action, the Examiner argues that he is not persuaded by the foregoing discussion, because "said arguments are presented without any factual evidence". In this, the Examiner misses the point. The point is not whether or not Appellants' can provide data showing unexpected advantages, but whether or not the combination of references teaches or suggests Appellants' invention, i.e., whether or not the combination of references cited establishes a prima facie case for obviousness.

Clearly, no person skilled in the art would be motivated by the references cited to add Horiki's water-soluble polymer to Lühmann's adhesive, as the references show that there would be no benefits achieved from such addition, and that it is more likely that a harmful effect would result i.e., the Horiki reference would suggest that the strong bond that Lühmann desires would be weakened by the releasing effect of the water-soluble polymer.

Appellants' claims are clearly not obvious over any combination of the Lühmann

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and Horiki references.

The rejection of Claims 1-7 under 35 U.S.C. 103(a) as obvious over Lühmann et al. (US Patent 5,897,949) in view of Horiki et al. (US Patent 4,868,045) should accordingly be REVERSED.

8. CONCLUSION

Wherefore it is submitted that the final rejection is in error and should be REVERSED.

AUTHORIZATION TO CHARGE FILING FEE TO DEPOSIT ACCOUNT

Appellant is:

☐ a small entity

☒ other than a small entity

It is requested that the fee for the filing of the Brief on Appeal be charged to the undersigned's Deposit Account No. 14-1263.

Please charge:

☐ \$ 250.00 for small entity

☒ \$500.00 for other than small entity.

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CONDITIONAL PETITION FOR EXTENSION OF TIME

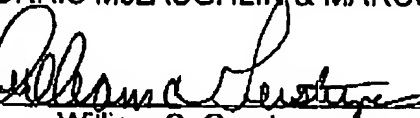
If any extension of time for this response is required, appellant requests that this be considered a petition therefor. Please charge the required Petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

Respectfully submitted,
NORRIS McLAUGHLIN & MARCUS, P.A.

By


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I hereby certify that this correspondence is being transmitted via facsimile, no. 571-273-8300 to the United States Patent and Trademark Office, addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 25, 2006.

By


Zsuzsa SchusterDate September 25, 2006

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9. CLAIMS APPENDIX

The claims are appeal read as follows:

1. A pressure sensitive adhesive for single-sided or double-sided adhesive sheet strips which is redetachable from a substrate without residue or destruction by stretching in the plane of the bond, comprising a mixture of at least one block copolymer, at least one tackifier, and at least one water-soluble polymer.
2. The adhesive as claimed in claim 1, wherein said water-soluble polymer is present in an amount of from 0.5 to 20% by weight, based on the weight of adhesive.
3. The adhesive as claimed in claim 2, wherein said amount of water-soluble polymer is from 2 to 8% by weight, based on the weight of adhesive.
4. The adhesive as claimed in claim 1, wherein said water-soluble polymer is selected from the group consisting of sodium salts of polyacrylic acids, starch-modified polyacrylic acids, polyacrylamides, polysulfonic acids, polyvinylpyrrolidone, polyvinyl alcohol and carboxymethylcellulose.
5. The adhesive as claimed in claim 1, 2, 3 or 4, wherein said mixture further comprises at least one additive selected from the group consisting of antioxidants, light stabilizers and plasticizers.
6. The adhesive as claimed in claim 1, 2, 3 or 4, wherein said mixture further comprises at least one filler selected from the group consisting of silica, glass (ground or in the form of beads), alumina, zinc oxide, calcium carbonate, titanium dioxide and carbon black.
7. A single-sided or double-sided adhesive sheet strip comprising the pressure sensitive adhesive of claim 1, 2, 3 or 4.

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10. EVIDENCE APPENDIX

No evidence under §§ 1.130, 1.131, or 1.132 has been submitted.

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11. RELATED PROCEEDINGS APPENDIX

There have been no decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of 37 CFR 41.37